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10/719,706	11/21/2003	Douglas Paul Arduini		2959

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EXAMINER

SANDY, ROBERT JOHN

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/719,706

Applicant(s)

ARDUINI, DOUGLAS PAUL

Examiner

Robert J. Sandy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/17/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Drawings***

Figures 1A and 1B have been designated by the application (see pages 7 and 10 of the written specification) and should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features pertaining to "one inner or outer clamping arm (loop) is part of a base or backing plate to act as a clip board or book binder or notebook binder or notepad" (claims 13, 17 and 20); and "wherein the dual outer clamping arms are not parallel with the inner loop, but form toward the center of the inner loop to terminate near each other as outer clamping arms." (claim 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

Claims 1-6, 10, 13, 17 and 20 are objected to because of the following informalities:

In each of claims 6, 7, 8, 10, 13, 17 and 20, the term “claming” should be changed to - - clamping - -.

Claim 1 consists of two sentences, which is improper. For the purposes of this first action on the merits, the subject matter provided in the first sentence of claim 1 has been considered to constitute claim 1.

In each of claims 13 and 17, the phrase “where one inner ...” should be changed to - - wherein the one inner - -.

Appropriate correction of all of the above is required.

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no antecedent basis for the claimed subject matter pertaining to “wherein the dual outer claming arms are not parallel with the inner loop, but form toward the center of the inner loop to terminate near each other as outer clamping arms.”

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old.

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It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an enabling disclosure teaching how to make the claimed invention, as to the following: The specification fails to provide an enabling disclosure teaching how to make the claimed invention having the following structural combinations:

where both the dual outer clamping arms being outside the width of the long side of the inner clamping loop (claim 1) and “wherein the dual outer clamping arms are inside the width of the long sides of the inner clamping arm loop” (claim 3); and

where both the dual outer clamping arms being outside the width of the long side of the inner clamping loop (claim 1) and “wherein the dual outer clamping arms are at the same width of the long sides of the inner clamping arm loop” (claim 4);

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 4 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as to the following:

In claim 1, line 2, there is no antecedent basis for "the middle of the length".

In claim 1, line 3, recitation of "each other" is undefined.

In claim 1, bridging lines 2 and 3, there is no antecedent basis for "the inner clamping arm".

In claim 1, line 4, there is no antecedent basis for "the parallel plane" and "the first loop"

In claim 1, bridging lines 5 and 6, recitation of "each terminating end" is undefined.

In claim 1, line 6, there is no antecedent basis for "the axis".

In claim 1, line 7, there is no antecedent basis for "the long sides".

In claim 1, bridging lines 7 and 8, there is no antecedent basis for "the inner clamping arm loop".

In claim 1, line 8, recitation of "the length" is undefined.

In claims 2 and 19, recitation of "some other spring material and/or shape" renders the claim indefinite since the claim does not define the "some other spring material and shape."

In claim 5, bridging lines 1 and 2, there is no antecedent basis for "the inner clamping arm "U" shape".

In claim 5, recitation of "oval versus rectangular" renders the claim indefinite since it is not understood what particular aspect of the claimed invention is "rectangular".

In claim 9, bridging lines 1 and 2, recitation of "any other material" renders the claim indefinite since the claim does not define the "any other material."

In claim 12, line 5, there is no antecedent basis for "the two terminations".

In claim 13, line 2, there is no antecedent basis for the "outer clamping arm loop".

The above occurrences of indefiniteness are not meant to be an exhaustive list, and applicant should review all claims in their entirety for further occurrences of indefiniteness.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-20, so far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukamoto (U. S. Patent No. 4,523,354, cited by applicant). Tsukamoto ('354) a length of spring wire (10) formed into dual crisscrossing spring-type legs (13) that expand by the thickness of the paper (14) or material being clamped or clipped and are connected to a lower clamping arm loop (11) and also connected to dual upper clamping arms (18), thereby providing continuous clamping pressure and mitigating bending and twisting distortion of the clamping arms; (concerning claim 19, so far as definite) the spring wire is some other spring material (i.e., "the clip may be made from semi-hard steel wire, stainless steel wire, nonferrous-metal wire, plastic wire having high strength or resemble wire.", col. 6, lines 51-54); and (concerning claim 20, so far as definite) the lower or upper clamping arm or arms is part of a base (18).

Claims 1-7, 9, and 12-17, so far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Steinberger (U. S. Patent No. 400,138, cited by applicant). Steinberger ('138) discloses a length of spring wire (see Figures 1-6) formed into a long "U" shape rectangle loop in the middle of the length as the inner clamping arm, then form each end of the length to criss-cross each other as dual connecting legs in the parallel plane of the first loop forming a box shape in the middle of the length, then form each terminating end into dual outer clamping arms along the axis in parallel and outside the width (see Fig. 3) of the long sides of the inner clamping arm loop, such that the length is the same as the length of the inner clamping arm loop; (concerning claim 2) the spring wire is some other shape (e.g., see Figures 5); (concerning claim 3) the dual outer clamping arms are inside the width of the long sides of the inner clamping arm loop (see Figs. 1 and 3); (concerning claim 4) the dual outer clamping arms are at the same width of the long sides of the inner clamping arm (see Fig. 5); (concerning claim 5) the inner clamping arm "U" shape is oval (see Fig. 5); (concerning claim 6) the dual outer clamping arms are longer

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than the length of the inner clamping arm (see Fig. 1); (concerning claim 7) the dual outer clamping arms are shorter than the length of the inner clamping arm (see Fig. 1); (concerning claim 9) wherein any other material ("letters", line 5) is clamped or clipped other than paper; (concerning claim 12) the terminating ends are extended and shaped in bends toward each other in the same plane or axis as the inner loop clamping arm, thereby forming an outer loop clamping arm similar to the inner loop clamping arm with a gap where the two terminations meet (Figs. 1-3); (concerning claims 13 and 17) one of the inner or outer clamping arm loop is part of a base or backing plate to act as a clip board or book binder or notebook binder or notepad and for various clamping applications (see Fig. 4); (concerning claim 14) the gap where the two terminations meet may be anywhere in the inner or outer loop clamping arm's length or width, or meet in one of the crisscrossing legs; (concerning claim 15) the inner or outer loops may be of different length and/or width of each other (Figs. 1 and 5); and (concerning claim 16) the inner or outer loops are oval instead of rectangular and of different widths to allow one to move inside the other as inner and outer loop clamping arms with the paper or other material clamped or clipped in between (Fig. 5).

Claims 1, 8, 10, and 11, so far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Sacerdote (U. S. Patent No. 1,753,094, cited by applicant). Sacerdote ('094) discloses a length of spring wire formed into a long "U" shape rectangle loop in the middle of the length as the inner clamping arm, then form each end of the length to criss-cross each other as dual connecting legs in the parallel plane of the first loop forming a box shape in the middle of the length, then form each terminating end into dual outer clamping arms along the axis not in parallel (see Figures 2, 5, 7, and 10) with the inner loop, but form toward the center of the inner loop to terminate near each other as outer clamping arms, and outside the width of the long sides of the inner clamping arm loop, such that the length is the same as the length of the inner clamping arm loop; (concerning claim 10) the dual outer clamping arms length terminating ends are shaped into loops (24, 25) or rolled-end termination tips to prevent scraping of the paper or other clamped or clipped material; and (concerning claim 11) the dual outer clamping arm length terminating ends are shaped with rounded (24, 25) to prevent scraping of the paper or other clamped or clipped material.



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*Conclusion*

The above objections and rejections to the claims under 35 U.S.C. § 112 are indicative of numerous grammatical and idiomatic errors found in the claim language, and are not meant to be an exhaustive list, and applicant should review all claims in their entirety for further objectionable informalities.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is 703-305-7413. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ROBERT J. SANDY**  
**PRIMARY EXAMINER**

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Primary Examiner  
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